

REMARKS

Claims 1-30 are pending in the Application.

Claims 1-30 stand rejected.

Claims 8-9 have been objected to.

Applicant greatly appreciates the time expended by the Examiner in discussing the rejections over the telephone.

I. REJECTIONS UNDER 35 U.S.C. § 112

Claims 8-9 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner asserts that the terms "circuitry" within these claims require description.

Applicant respectfully traverses this rejection. Claims 8 and 9 recite an Internet service provider (ISP) system, which includes circuitry for performing various steps as recited within the other claims in the application, and as described within the Specification and in the flow diagrams of Figures 2A and 2B. The circuitry for performing such steps is shown in Figure 3, which is described in the Specification on pages 11-13.

The Specification specifically teaches that the data processing system 300 may be used for implementing any of the systems shown in Figure 1, including the ISP 102. The method steps described in Figures 2A – 2B are executed within the hardware of system 300, and such hardware is physically changed as each step of the flow diagrams is performed. See Specification, page 13, lines 1-4. Thus, as the method steps are executed within 300, the various "circuitries" within system 300 perform such steps as the electrical signals pass through the circuitries in accordance with program instructions running such method steps. Therefore, as each step is performed, the hardware within system 300 includes the "circuitry for" performing such method steps. For example, when the ISP inserts an age group into a field of the request, various portions of system 300 are executing this step. When they do, their

"circuitry" is being modified with electrical signals. This method of claiming hardware has been performed a large number of times in a multitude of issued patents.

II. REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-5, 8-12, 16-21, 23-25 and 29-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Bowker et al.* (U.S. Patent No. 6,317,790). In response, Applicant respectfully traverses these rejections. As the Examiner is well aware, for a claim to be anticipated under 35 U.S.C. § 102, each and every element of the claim must be found within the cited prior art reference.

Bowker teaches a system that includes a web server for receiving a request from a client. Abstract. Rather than directly supplying the requested information, the server determines whether unrequested operations should be performed, and if so, performs such unrequested operations before returning the originally requested information to the client. *Id.* *Bowker* specifically teaches that in the context of the World Wide Web, the client is a browser, the described server is a web server, and the requested information is a web page. Column 2, lines 12-15. Such a client will send a request using its web browser over the Internet to a web server for particular information, which in this context is a web page. The web server will determine whether it should interrupt the request by comparing supplemental information associated with the client to a database maintained by the web server. Column 2, lines 22-24. If the server determines that it is going to interrupt the request and perform the additional operations, such operations will be performed, and then the web page will be returned by the web server to the browser within the client system. Column 2, lines 29-33.

Bowker specifically describes the ISP 326 in Figure 3 as being separate from such a web server 330, 406, and specifically defines the ISP 326 as providing data communication services through the World Wide Packet Data Communication Network now commonly referred to as the Internet 328. Column 4, lines 46-48.

Thus, according to the teachings of *Bowker*, there can be no confusion about what functions are being described in *Bowker* to be performed by the web server 330, 406, and which functions are being performed by the ISP 326. As discussed with the Examiner over the telephone, the functions cited by the Examiner in support of his rejections are performed by the web server 330, 406, which is described in *Bowker* to be connected through the Internet 328 to the ISP 326. Therefore, *Bowker* is not referring to a web server operating in conjunction with the ISP 326, as suggested by the Examiner in the telephone conference. Therefore, Applicant respectfully asserts that the Examiner cannot reasonably equate the ISP recited within the claims with the web server 330, 406 described in *Bowker*, since *Bowker* specifically differentiates the web server 330, 406 from the ISP 326.

Regarding claims 1, 10, 18 and 23, the Examiner has asserted that *Bowker* teaches the step of the ISP inserting the predetermined fact about the user into a field in a request from the user's browser for a particular web page. This is not correct. The language cited by the Examiner in column 2, lines 30-40 does not teach inserting the predetermined fact about the user into a field in the request by the ISP. Instead, this language merely teaches that the web server, not the ISP, may perform the interrupt process to perform unrequested operations during an authentication process when the client user has requested restricted information from the web browser. There are absolutely no teachings within *Bowker* of the ISP 326 inserting a predetermined fact about a user into a field in the request from the user's browser for a particular web page.

Furthermore, *Bowker* does not teach forwarding the request that has now been modified with the inserted predetermined fact to the web server addressed by the request from the client. In *Bowker*, the ISP 326 merely performs the process of connecting the client system 300 to the web server 330 over the Internet 320. *Bowker* does not teach or suggest that the ISP 326 performs any further functions, as specifically recited within the claims.

As a result, Applicant respectfully asserts that claims 1, 10, 18 and 23 are not anticipated by *Bowker*.

More specifically with respect to claim 10, claim 10 is a method that is implemented within the ISP system. Again, claim 10 recites that the ISP intercepts the request from the user's browser and inserts a predetermined fact about the user into a field in the request, and thereafter forwards that modified request to the web browser. Such functionality is not performed by the ISP 326 as taught within *Bowker*.

Specifically, with respect to claim 18, this claim specifically recites each of the client machines loaded with a web browser, an ISP coupled to the Internet, and a web server coupled to the Internet where the web server is accessible by the client machine's browser through the ISP. Claim 18 goes on to further specifically recite that the ISP performs the steps of intercepting the request from the browser and inserting the predetermined fact about the user into a field in the browser request, and thereafter forwarding such a modified request to the web server addressed by the request. Again, the ISP 326 taught in *Bowker* does not perform such steps. Instead, such steps within *Bowker* are performed by the web server, not the ISP.

Applicant respectfully asserts that claims 8 and 9 are also patentable over *Bowker* for similar reasons as given above with respect to claims 1, 10, 18 and 23.

III. REJECTIONS UNDER 35 U.S.C. § 103

Claims 6-7 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Bowker* in view of *Martin et al.* (U.S. Patent No. 6,606,607). In response, Applicant respectfully traverses this rejection. These claims recite the calculation of a sales tax rate to apply to a purchase made by the user as a function of the user's geographical location, calculating such a sales tax and charging it to the user. The Examiner admits that *Bowker* does not teach these limitations, and so adds *Martin* for these teachings. Though *Martin* does teach the calculation of a sales tax to apply to a purchase made using an e-commerce method, and that this sales tax is calculated using the zip code where the product is to be shipped, *Martin* teaches that this geographic information (i.e., zip code) is entered by the bidder when requested by the e-commerce site. Column 7, lines 22-31. In contrast, claims 6-7 and 22 recite that

such a sales tax rate is calculated using the geographic information that is inserted by the ISP into a field in the request for information from the user, and not inserted by the user with their web browser. Therefore, *Bowker* and *Martin* taken together do not teach or suggest the calculation of a sales tax and charging it to the user of the web browser as a function of geographical information pertaining to the user that has been inserted by the ISP, which has intercepted the request from the user. Therefore, one skilled in the art at the time the invention was made would not have been able to recreate the invention as recited within claim 6-7 and 22 in view of *Bowker* and *Martin*. The Examiner goes on to state that "it would have been obvious to one of ordinary skill of the art at the time of invention was made to combine *Bowker* with *Martin* because it would provide calculating and providing sales tax and shipping cost for the product in accordance with zip code of the location on fly [*sic*]." Furthermore, the Examiner's motivation to combine the references is merely his subjective opinion. Only objective facts can support a motivation to combine references.

Claims 13-15 and 26-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Bowker* in view of *McNabb et al.* (U.S. Patent No. 6,289,462). In response, Applicant respectfully traverses this rejection. The Examiner asserts that *McNabb* teaches the inserting of the predetermined fact into a cookie, into a FROM field within the request, and into a header field within the request. The problem with these assertions is that the claimed steps of inserting the predetermined fact about the user into these various optional embodiments is performed by an ISP, and this is not taught by either *Bowker* or *McNabb* or their combination. As Applicant has clearly asserted previously, *Bowker* does not teach that the inserting step is performed by an ISP. Applicant further asserts that *McNabb* does not teach that such an inserting step is performed by an ISP, but is instead performed by an upgrade/downgrade enforcer (UDE), which is located in conjunction with the web servers to which requests are sent. Column 8, lines 50-53. Thus, the combination of *McNabb* and *Bowker* does not teach or suggest the specifically recited claims.

Furthermore, with respect to claims 13 and 26, the Examiner has cited column 13, lines 49-60 in *McNabb* for teaching this limitation. This language teaches

that if a cookie is available with a request, it is used to direct a request. However, this language does not teach or suggest that such a cookie is inserted by an ISP, but instead suggests that this is a cookie sent by the client web browser. Thus, there is no teaching or suggestion within the prior art references, singularly or in combination, that teaches or suggests the inserting of the predetermined fact about the user by the ISP into a cookie with the request.

With respect to claims 14 and 27, the Examiner has specifically cited column 11, lines 56-60 of *McNabb*. However, Applicant respectfully asserts that this language teaches that the UDE program examines an incoming data packet, but does not specifically teach that there is an insertion of a predetermined fact about a user by an ISP into the FROM field within the request. Applicant further points out that the UDE is shown as being embodied within the server in Figure 1, which is not the same as the ISP, which would be connecting the various computers illustrated in Figure 1 to the Internet.

The same is true with respect to claims 15 and 28, where the Examiner has again cited column 11, lines 56-60. As a result, one skilled in the art at the time the invention was made would not have been able to recreate the claim limitations as specifically recited in view of *Bowker* and *McNabb*.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicant that the remaining claims in the Application are in condition for allowance, and respectfully request an early allowance of such claims.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicant

By: 

Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2851

AUSTIN_1\249089\1
7047-P407US 04/27/2004